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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,625	03/23/2004	Mark A. Olson	2297.MOLS.PT	2653
26986 7590 07/23/2007 MORRISS OBRYANT COMPAGNI, P.C. 734 EAST 200 SOUTH SALT LAKE CITY, UT 84102			EXAMINER SANDERS, JANIS C	
			ART UNIT 1732	PAPER NUMBER
			MAIL DATE 07/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,625

Applicant(s)

OLSON, MARK A.

Examiner

Janis Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction election

1. Applicant's election of Group I, claims 1-11, in the reply filed on 26 April 2007 is acknowledged. Due to applicant's lack of opposition to the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 12-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected ear/nose plug product, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 26 April 2007.

Response to Amendment

3. Applicant's amendment to claims in the reply filed on 26 April 2007 is acknowledged. Claims 1-11 are currently pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe (U.S. Patent 3,782,379), and further in view of Ahn et al (U.S. Patent Application Publication 2003/0013802).

Lampe discloses a method of forming earplugs reading on claim 1. Lampe teaches providing a room-temperature vulcanizable silicone rubber composition that is easily molded by hand (module) to form ear plugs in situ. See lines 61-66 in column 2 and 3-8 in column 3. Lampe further teaches that the composition includes polysiloxane and catalyst materials. See the Abstract. Lampe further teaches that the mixed composition results in a putty-like mass and has a curing wait time. See lines 63-68 in column 9 and 1-5 in column 10.

Lampe teaches that high molecular weight diorganopolysiloxane is blended with low weight diorganopolysiloxane (thereby producing a moderately low molecular weight polymer), as required by claim 2. See lines 62-68 in column 6 and 1-18 in column 7. A filler is included, as also required by claim 2. See lines 58-63 in column 8.

Lampe teaches mixing by kneading, as required by claim 4. See lines 55-60 in column 9.

Lampe teaches that the ingredients of the mixture can be divided into two parts: One part having organopolysiloxane polymer with filler (silicone part) and a second part having alkyl silicate with metallic salt (catalyst part). These two components are only mixed together when curing is to begin. See lines 47-60 in column 9.

Lampe does not teach that the mixture parts are equal, as required by claim 1.

Ahn et al, hereinafter "Ahn", teaches an A-B mixture of silicone and catalyst, wherein part A is mixed equally with part B. See paragraph [0162]. It would have been obvious to one

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of ordinary skill that the mixture parts of Lampe could be balanced equally in the manner of Ahn by distributing the inert filler component.

Lampe does not teach mixing by spatula, as required by claim 5.

Ahn teaches that a spatula is used to mix components. See [00162].

Lampe and Ahn are combinable because they are concerned with a similar technical field, namely, vulcanizable silicone compositions. One of ordinary skill in the art at the time of the invention would have found it obvious to include the mixture ratio of Ahn in the compounding process of Lampe. The motivation to do so would have been the simplicity of equal weight ingredient bags. See lines 47-60 in column 9 of Lampe.

Lampe does not teach a removal feature for the molding, as required by claims 1 and 11. It would have been obvious to one of ordinary skill, however, to form a graspable shape for retrieval.

Lampe does not teach rolling a 0.5-1.5 cm³ ball with a tapered end, as required by claim 6, or a 2-4 cm³ ball, as required by claim 8, or forming a bullet shape, as required by claim 7. It would have been obvious to one of ordinary skill, however, that these features are optimizable. A plug to fit the ear or nose would have to be of an insertable size and a narrowed end would facilitate insertion while defining a bullet shape. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

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6. Claims 3 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Ahn as applied to claims 1-2, 4-8 and 11 above, and further in view of Onohara et al (U.S. Patent 4,834,721).

Lampe/Ahn teach the method of claims 1-2, 4-8 and 11, as discussed above.

Lampe teaches that the alkyl silicate component of the catalyst part contains vinyl groups, as required by claim 3. See lines 25-28 in column 7.

Lampe/Ahn does not teach chloroplatinic acid for a component of the catalyst, as required by claim 3. Lampe/Ahn further does not teach an insertion time of 1-3 minutes, as required by claim 9, or a cure time of 3-5 minutes, as required by claim 10.

Onohara et al, hereinafter "Onohara", teaches use of a chloroplatinic acid catalyst in an addition reaction with a polysiloxane having vinyl groups. See lines 9-15 in column 6 and 3-12 in column 11. Onohara further teaches that such a composition with a platinum type catalyst can cure in 5 minutes at 30° C (below body temperature). See lines 3-12 in column 11. Since the cure is substantively complete in 5 minutes, and the preparation would require some time, maybe 1-2 minutes, it would have obvious to one of ordinary skill that the optimum insertion time preserving malleability would be 2-3 minutes from the onset of mixing .

Lampe/Ahn and Onohara are combinable because they are concerned with a similar technical field, namely, silicone compositions. One of ordinary skill in the art at the time of the invention would have found it obvious to include the catalyst of Onohara in the compounding process of Lampe/Ahn. The motivation to do so would have been to hasten cure time. See lines 63-38 in column 9 of Lampe.

Response to Arguments

7. The amendment filed 26 April 2007 is sufficient to overcome the objection to the specifications.
8. Applicant's arguments filed 26 April 2007 have been fully considered but they are not persuasive.
9. **Applicant's arguments appear to be on the following grounds:**
 1. The applicant first argues the rejection of claims 1, 2, 4-8, and 11 over Lampe in view of Ahn et al. because both Lampe and Ahn et al. teach silicone compositions having a long cure time. This is in sharp contrast with the present invention, which has a short cure time of about 3 to 5 minutes, as required by claim 10. Therefore, to produce a quick curing rubber ear or nose plug a person of ordinary skill in the art would not be motivated to combine the slow cure time compositions of Ahn et al. with the slow cure time of Lampe. As a result, there is no proper motivation to combine the references.
 2. The applicant further argues that reference Ahn et al. teaches away from ear and nose plugs, disclosing silicone compositions "having unexpectedly improved adhesion to plastic substrates [0107]." Since Ahn et al. teaches away from a silicone rubber useful in

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the construction of an ear or nose plug, it is improper to combine this reference with Lampe.

3. The applicant's finally argues the rejection of claims 3, 9 and 10 over Lampe in view of Ahn et al. and Onohara et al. Onohara et al. teaches that "it is absolutely necessary in the present invention that, for strong adhesion to thermoplastic resins ..." (col. 7, lines 41-448). Therefore, both Ahn et al. and Onohara et al. teach away from a silicone rubber base to conform to the ear or nose cavity. Thus, Onohara et al. does not overcome the shortcomings of Ahn et al. and Lampe.

10. **These arguments are not persuasive for the following reasons:**

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, references Lampe and Ahn are combinable because they are both concerned with a similar technical field, namely, vulcanizable silicone compositions. However, the applicant's argument is with

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the long cure time disclosed in the combination of Lampe and Ahn, opposing requirements of claim 10, having a short cure time of 3-5 minutes. It is the view of the examiner that claim 10 has been addressed under the 35 USC § 103 rejection over Lampe in view of Ahn, in further view of Onohara. Onohara et al. teaches use of a chloroplatinic acid catalyst in an addition reaction with a polysiloxane having vinyl groups. See lines 9-15 in column 6 and 3-12 in column 11. Onohara further teaches that such a composition with a platinum type catalyst can cure in 5 minutes at 30° C (below body temperature). See lines 3-12 in column 11. Lampe/Ahn and Onohara are combinable because they are concerned with a similar technical field, namely, silicone compositions. One of ordinary skill in the art at the time of the invention would have found it obvious to include the catalyst of Onohara in the compounding process of Lampe/Ahn. The motivation to do so would have been to hasten cure time. See lines 63-38 in column 9 of Lampe.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although Ahn suggests using the composition for adhesive purposes, Lampe discloses a method of forming earplugs reading on claim 1. Lampe teaches providing a room-temperature vulcanizable

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silicone rubber composition that is easily molded by hand (module) to form ear plugs in situ. See lines 61-66 in column 2 and 3-8 in column 3. References Lampe and Ahn are combinable because they are concerned with a similar technical field, namely, vulcanizable silicone compositions.

3. In response to the applicant's argument of the 35 USC § 103 rejection of claims 3, 9 and 10 over Lampe in view of Ahn et al. and Onohara et al., that Onohara further teach away from a silicone rubber base to conform to the ear or nose cavity. Onohara et al. teaches that "it is absolutely necessary in the present invention that, for strong adhesion to thermoplastic resins ..." (col. 7, lines 41-448). It is the view of the examiner that although Onohara suggests using the composition for adhesive purposes, Lampe discloses a method of forming earplugs reading on claim 1. Lampe teaches providing a room-temperature vulcanizable silicone rubber composition that is easily molded by hand (module) to form ear plugs in situ. See lines 61-66 in column 2 and 3-8 in column 3. References Lampe/Ahn and Onohara are combinable because they are all concerned with a similar technical field, namely, silicone compositions.

Remarks

11. No claim is allowed.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis Sanders whose telephone number is 571-272-7145. The examiner can normally be reached on M-F 8-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janis Sanders
Patent Examiner
Art Unit 1732

7/10/07


CHRISTINA JOHNSON
ADVISORY PATENT EXAMINER
7/13/07